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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,071	02/04/2004	Charles D. Huston	5863-00203	1712

7590 10/25/2006

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EXAMINER	
ISSING, GREGORY C	

ART UNIT	PAPER NUMBER
3662	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/772,071	HUSTON ET AL.	
	Examiner	Art Unit	
	Gregory C. Issing	3662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-39 and 41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-39 and 41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. In view of the Appeal Brief filed on 8/10/06, PROSECUTION IS HEREBY REOPENED. New Grounds of Rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

2. A note on the effective filing date of the application. The following is a list of the related patent applications:

#1 07/804,368, filed Dec. 10, 1991, patent 5,364,093

#2 08/313,718, filed Sept. 22, 1994, C-I-P of #1

#3 08/366,994, filed Dec. 30, 1994, C-I-P of #2

#4 08/926,293, filed Sept. 5, 1997, CON of #3

#5 10/772,071, filed Feb. 4, 2004, CON of #4

Application #4 was decided by the Board of Patent Appeals and Interferences as well as by the Court of Appeals for the Federal Circuit. The Courts agreed with the Examiner that the Appellants were not entitled to the benefit of earlier-filed applications #1 and #2 since they did not disclose the claimed subject matter in a manner provided by the first paragraph of 35 USC 112, specifically with regard to displaying an advertising message to a golfer. Each of the BPAI and the CAFC (under Discussion I)

agreed that the earlier-filed applications did not disclose the location-specific transmission of advertising messages to a golfer using GPS.

3. Regarding the instant application, each of the claims is directed to displaying an advertising or stored message based upon a comparison of an instant GPS position and a message location. As noted above, the display of location-based advertising messages is not supported by the above-noted applications #1 and #2. The display of location-based messages which are stored is not supported by application #1; application #2 simply provides the statement on page 13 "the tips are just that – memory storage 25 contains caddie hints for the current location of the cart." Thus, the claims directed to location-based presentation of advertisements and location-based display of messages based on the activity of the golfer (21-31 and 36, and 39 respectively) are only entitled to the benefit of an earliest-filed application teaching such, which is application #3 above. The claims directed to location-based presentation of a message (claims 32-35, 37-38 and 41) are only entitled to the benefit of the earliest-filed application teaching such, which is application # 2 above.

4. Regarding the patents to Paul and Dimitriadis et al, the effective priority date for Paul is May 2, 1994, and the effective filing date of Dimitriadis et al is July 29, 1994. All of the subject matter for which Dimitriadis et al is cited can be found in its parent application 08/282,893, see claims 1-2 for providing time and location sensitive advertising information to a user, wherein the position, as disclosed in the specification, is derived from GPS. U.S. Patent 5,627,549 to Park corresponds to the specification of 08/282,893, wherein 08/585,604 (Park) is a continuation (FWC) of 08/282,893.

5. NEW GROUNDS OF REJECTION

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided

the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 21-39 and 41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,364,093 in view of any one of Paul (5,524,081), Dudley (5,326,095), or Dimitriadis et al (5,664,948).

8. Huston et al teach a method and system for displaying a distance to a golfer on a golf course using a global positioning satellite system comprising (1) positioning a remote GPS receiver on a golf course, (2) determining present position as well as a corrected position of the golfer, (3) displaying a distance between the golfer and a selected target on the golf course.

9. Huston et al do not disclose selecting one or more advertising locations on the golf course and displaying advertising messages to the golfer if the present position is an advertising location (claims 21-31). Huston et al do not disclose a memory storing a set of message locations/messages and displaying a message when the determined position is at one of the message locations (claims 32-39 and 41).

10. Paul discloses "based on location, the unit retrieves stored pro's notes that provides strategy based on the current lie and other elements of the golfer's play" (7:6-8). Dudley discloses "the look-up table contained in EEPROM 90 and RAMs92 and 94 for microcontroller 88 can also include advertisement messages which are activated by particular tags 24" (7:14-17). Dimitriadis et al disclose "presentation of advertising information at the receiving device may be triggered by a variety of functions . . . by reference to . . . current receiving device location" (2:3-21 and 4:24-39).

11. Thus, it would have been obvious to one having ordinary skill in the art to modify Huston et al by incorporating position-based message retrieval in view of the conventionality of such as shown by any one of Paul, Dudley and Dimitriadis et al wherein each teaches that it is known to retrieve a message, including advertising messages, based on the location of a mobile receiver. Paul teaches message retrieval on a golf course, Dudley teaches advertising information retrieval on a golf course, and Dimitriadis et al teach message and advertising information retrieval on a traveled path.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claims 32, 33, 35, 37, 38, 39, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Paul (5,524,081).

14. Paul teaches a method and apparatus for displaying information to a golfer on a golf course using a global positioning satellite system comprising a GPS receiver 7 positioned on a golf course (Figure 1) for receiving signals from GPS satellites 2, a computer 16 for processing the received signals as well as differential correction information from receiver 9 for determining the position of the golfer, and a graphical display device 18 for displaying information to the golfer. The processor is pre-loaded with maps of the hole layouts 29 such that the golfer's position is displayed relative to the map and allows the CPU to calculate distances to targets and other critical information. Additionally, based on location, the unit retrieves stored messages in the form of pro's notes based on the current lie and other elements of the golfer's play (7:6-8); thus, teaching a memory storing a set of message locations with associated messages.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 21-31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of either one of Dimitriadis et al (5,664,948) or Dudley(5,326,095).

17. Paul teaches the subject matter substantially as claimed as set forth above, specifically the retrieval and display of a message to a golfer based on the golfer's GPS position. Paul also teaches the base unit broadcasting updated scores and information to the golfers thus suggesting the display of a scorecard (8:21-24). Lastly, Paul teaches allowing the golfer to place food and beverage orders from the cart-mounted units ahead of time so that the order is available at the turn-around; this obviously suggests the display of a refreshment order page on the mobile unit.

18. Paul differs from the claimed subject matter since the retrieval and display of an advertisement message is not specified.

19. Dudley discloses "the look-up table contained in EEPROM 90 and RAMs 92 and 94 for microcontroller 88 can also include advertisement messages which are activated by particular tags 24" (7:14-17). This teaches the position-based retrieval of stored advertisement messages for display to a golfer. Dimitriadis et al disclose "presentation of advertising information at the receiving device may be triggered by a variety of functions . . . by reference to . . . current receiving device location" (2:3-21 and 4:24-39). This clearly teaches the desire to retrieve and display advertisements based on the position of a mobile user. The desire to provide advertisements is by its very nature advantageous as a means to generate monetary gains.

20. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Paul by additionally providing location-based retrieval and display of advertisements in view of the conventionality of such as shown by each of Dimitriadis et al and Dudley so as to provide additional cash flow to the golf course. Additionally, in view of the teachings of Dimitriadis et al to provide a set of conditions indicating presentation, which set of conditions are modifiable, it would have been obvious to the skilled artisan to display advertising messages based on a condition of

movement of the device, such as advertising restaurants when moving away from the18th hole or providing advertisements for clothing and equipment while the golfer is stationary and waiting for a group ahead to finish, thus, not distracting the golfer from driving by providing information while stationary.

21. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul as applied to claim 32-33 above, and further in view of Bonito et al (WO 88/00487).

22. Paul teach the apparatus for displaying a message to a golfer substantially as claimed as set forth above but fail to show the use of a pen for providing inputs to the display.

23. Bonito et al teach the conventionality of a light pen 95/97 to provide input with respect to a displayed graphic of a golf hole layout on a golf computer display 19.

24. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Paul by incorporating a pen as an input device over a graphical overlay in order to mark targets, such as sand traps and tree in the fairway, along the golf hole in view of the teachings of Bonito et al and thereby aid the golfer in selecting desired information with respect to selected targets on the golf layout using conventional means.

25. The grounds of rejection set forth in the Final Office Action are withdrawn in favor of the new grounds set forth above.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory C. Issing
Primary Examiner
Art Unit 3662

gci

Re-open approval

Thomas Tarcza

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